

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  EMT-003	
	Application Number 10/081,411-Conf. #1565	Filed February 20, 2002	
	First Named Inventor Avner Schneur et al.		
	Art Unit  3627	Examiner  M. A. Shaawat	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 60%;"> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>50,389</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>                    </u></p> </div> <div style="width: 35%; text-align: center;"> <p><u>/Robert S. Biasi/</u> Signature</p> <p><u>Robert S. Biasi</u> Typed or printed name</p> <p><u>(617) 570-1408</u> Telephone number</p> <p><u>April 9, 2009</u> Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<input type="checkbox"/> *Total of <u>          </u> forms are submitted.			

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Schneur et al.  
APPLICATION NO.: 10/081,411 ART UNIT: 3627  
FILING DATE: February 20, 2002 EXAMINER: Shaawat, Mussa  
TITLE: Auction Management with Business Volume Discount

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Commissioner for Patents  
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COMMENTS ACCOMPANYING SECOND REQUEST  
FOR PRE-APPEAL BRIEF CONFERENCE

In response to the Office Action mailed on January 2, 2009, we respectfully submit these  
Comments:

**Remarks** begin on page 2 of this paper; and

**Conclusion** begins on page 5 of this paper.

In accord with the Official Gazette Notice of July 12, 2005, this paper accompanies a  
Pre-Appeal Brief Request for Review, a Notice of Appeal, a Petition for Extension of Time, and  
the fee for the filing of the Notice of Appeal.

Please charge our Deposit Account No. 07-1700 in the amount of \$670.00 to cover the  
fees set forth in 37 C.F.R. 1.17(a)(1) and 37 CFR 41.20(b)(1). The Director is hereby authorized  
to charge any deficiency in the fees filed, asserted to be filed, or which should have been filed  
herewith (or with any paper hereafter filed in this application by this firm) to our Deposit  
Account No. 07-1700, under Order No. EMT-003.

## **REMARKS**

### **Rejection Under 35 U.S.C. § 101**

#### **Claims 8–14, 19 and 20**

The final Office Action rejected claims 8–14, 19 and 20 under 35 U.S.C. § 101 as directed to non-statutory subject matter, specifically as directed to computer programs. The Office Action claims that, “Software modules are non-statutory subject matter unless embodied within a computer-readable storage medium such as computer hard disk or the like” (emphasis added). Office Action at 2.

Claim 8 explicitly recites, “A computer-readable medium having encoded thereon software ... , the software comprising instructions for...” (emphasis added). This element is also present in all of the claims that depend from independent claim 8, i.e., claims 9–14, 19 and 20.

The Patent Office has explicitly sanctioned the patentability of “a claimed computer-readable medium encoded with a computer program” in those very words. MPEP 2106.01 (a claimed computer-readable medium encoded with a computer program ... is thus statutory) (emphasis added). This rejection contradicts the Office’s stated position and is inconsistent with the claim language in several recently granted patents. See, e.g., claim 18 of U.S. Patent No. 7,512,987 (“A computer-readable medium holding program instructions for...”). Accordingly, this rejection is clear error and should be withdrawn.

### **Rejection Under 35 U.S.C. § 102(e) over U.S. Patent Appl. Publ. No. 2003/0004850**

#### **Claims 1–20**

This assignee of this application is also the assignee of U.S. Patent Appl. Publ. No. 2003/0004850 (hereinafter “Li”). Accordingly, the assignee is familiar with the contents of Li and, as demonstrated below, Li does not anticipate the pending claims. In particular, Li fails to teach, “determining by a processor an optimal award schedule comprising an optimal combination of suppliers and a list of items to be ordered from each supplier to at least partially satisfy the purchase requisition utilizing the explicit offer of a business volume discount” (emphasis added).

For clarity, the limitation at issue concerns: (1) the determining of an optimal award schedule (2) utilizing the explicit offer of a business volume discount. The limitation is not satisfied by a reference that discusses either the determining of an optimal award schedule (i.e., (1)) or the offer of a business volume discount (i.e., (2)). The claim limitation requires the determining of an optimal award schedule utilizing the explicit offer of a business volume discount (i.e., (1) utilizing (2)).

Li teaches the use of business volume discounts in bidding (i.e., (2)). See Li at, e.g., [0014], [0113]–[0117]. Li, as published, claims in part “determining an optimal award schedule for at least partial satisfaction of said requisition” (i.e., (1)). See Li at, e.g., claim 1. Li does not teach or suggest determining an optimal award schedule using those business volume discounts, as is required by the limitation at issue.

The Office Action of July 28, 2008, claimed that the Abstract and paragraphs [0006], [0016], and [0064] of Li satisfied the limitation at issue. Our response of September 11, 2008, demonstrated that was clear error. Nothing in the Abstract mentions business volume discounts, or determining an optimal award schedule using business volume discounts (i.e., (1), but not (2)). Paragraph [0006] discusses the definition of an optimal award schedule, but does not mention business volume discounts at all, let alone for the computation of an optimal award schedule (i.e., (1), but not (2)). Paragraphs [0016] and [0064] discuss the computation of an optimal award schedule, but neither discusses the use of business volume discounts in that computation (i.e., (1), but not (2)).

The current rejection now claims that paragraphs [0114]–[0117], [0124]–[0128], [0096], [0097], [0011]–[0014], [0006]–[0007] and claims 27, 33, 38, 40, and 42 satisfy the element at issue. None of these citations support the current rejection.

Paragraphs [0114]–[0117] concern the use of business volume discounts in bidding, not the determination of an optimal award schedule using business volume discounts (i.e., (2), but not (1)). Paragraphs [0124]–[0128] concern the determination of an optimal award schedule, but do not discuss the use of business volume discounts in that determination (i.e., (1), but not (2)).<sup>1</sup>

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<sup>1</sup> These paragraphs may also have been selected for this rejection because they discuss the imposition of “private buyer constraints.” The rejection is unclear on this point. Regardless, the claims require a volume discount offered by a supplier. Constraints imposed by a buyer have nothing to do with the supplier’s offer.

Paragraphs [0096] and [0097] have nothing to do with the computation of an optimal award schedule or business volume discounts (i.e., neither (1) nor (2)).<sup>2</sup>

Paragraphs [0011]–[0013] concern the determining of an optimal award schedule under buyer-imposed constraints (i.e., (1), but not (2));<sup>3</sup> paragraph [0014] discusses the inclusion of business volume discounts in a seller-supplied bid (i.e., (2), but not (1)). None of paragraphs [0011]–[0014] discuss the determination of an optimal award schedule utilizing the explicit offer of a business volume discount as is required by the current claims. Paragraphs [0006] and [0007] discuss the computation of an optimal award schedule, but fail to mention business volume discounts at all, let alone for the determination of an optimal award schedule (i.e., (1), but not (2)).<sup>4</sup>

Published claims 27 and 38 of Li claim, in part, determining an optimal award schedule—they do not mention business volume discounts (i.e., (1), but not (2)).<sup>5</sup> Published claim 33 recites, in part, a bid including a business volume discount (i.e., (2), but not (1)). Claims 40 and 42 have nothing to do with the determining of an optimal award schedule using business volume discounts—they concern buyer-supplied weight values, and a business volume discount is a value supplied by a supplier, not a buyer (i.e., neither (1) nor (2)).

More to the point, Li cannot support this rejection because Li does not discuss the use of business volume discounts in the determination of an optimal award schedule. A review of Li and the instant patent application reveals that the “Detailed Description” sections of both references are similar, but the instant application includes additional discussion at pp. 20–21 concerning business volume discounts and pp. 34–36 concerning the determination of an optimal award schedule utilizing business volume discounts. Li does not include this material. Accordingly, these rejections are completely unsupported by Li and no rejection based solely on Li can anticipate the claims in this application as they currently stand.<sup>6</sup> These rejections are clear error.

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<sup>2</sup> See also footnote 1.

<sup>3</sup> See also footnote 1.

<sup>4</sup> See also footnote 1.

<sup>5</sup> See also footnote 1.

<sup>6</sup> As noted in our response of September 11, 2008, Li and the current application are commonly owned, so Li cannot be prior art against the instant application in an obviousness rejection. See 35 U.S.C. §103(c)(1).

Accordingly, we respectfully submit that Li does not disclose or suggest the determination of an optimal award schedule “utilizing the explicit offer of a business volume discount.” For this reason, independent claims 1 and 8 are patentable over Li, and the claims that depend therefrom are likewise patentable because they depend on a patentable base claim, and may also have additional patentable features.

### **CONCLUSION**

In light of the foregoing, we respectfully submit that there are clear errors in the Examiner’s rejections and that the Examiner has failed to consider essential elements of the independent claims in the present rejection.

Respectfully submitted,

Date: April 9, 2009

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